

REMARKS

This responds to the Office Action dated February 12, 2009.

Claims 185 and 261 are amended. As a result, claims 161-185, 218-236, 247, 250, 252 and 256-261 are now pending in this application.

§ 251 Rejection of the Claims

Claims 165-167, 185, 218-220, 236, 252 and 256-261 were rejected under 35 U.S.C. § 251 as being based upon a defective reissue Declaration filed July 10, 2001. A corrected Substitute Reissue Declaration is being filed herewith.

Claims 165-167, 185, 218-220, 236, 252 and 256-261 were rejected under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."¹

Referring to the discussion provided in the Final Office Action mailed February 12, 2009, the Examiner states that claims 165-167, 185, 218-220, 236, 252 and 256-261 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9 and concludes that the claims are barred by the recapture rule. The recapture rule and the scenarios under which the recapture rule bars reissue claims are addressed in MPEP 1412.02 titled "Recapture of Canceled Subject Matter." In pertinent part, MPEP 1412.02 states that if the reissue claims are claiming additional inventions or embodiments not originally claimed, then recapture is not present, and that the complete removal of a limitation that was added to obtain the patent is permitted where the replacement limitation provides a separate invention.²

¹ Final Office Action mailed February 12, 2009, page 4.

² MPEP 1412.02 (I)(C). ("If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.")

In the present reissue application, the claims are directed to method and system of facilitating ordering an item, where the order includes the automatically determined item identity and the retrieved previously stored personal information, and thus are related to additional inventions when compared to the inventions claimed in the original patent (e.g., a system configured to receive and execute a distributed computing application that alters an associated video program). Because the reissue claims are claiming additional inventions to that originally claimed, there is no recapture; and this is expressly clear from the guidance of the MPEP. Applicants respectfully request reconsideration and withdrawal of the rejection.

§ 112 Rejection of the Claims

Claim 185 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 185 has been amended and Applicants believe that any basis for the rejection has been overcome. Applicants respectfully request reconsideration and withdrawal of the rejection.

§ 103 Rejection of the Claims

Claims 165-167, 185, 218-220, 236, 252 and 256-261 were rejected under 35 U.S.C. § 103(a) as being obvious over Florin et al. (U.S. Patent No. 5,621,456) in view of Garneau et al. (U.S. Patent No. 5,497,420).

Florin discloses a home shopping interface in the context of a dedicated home shopping service, such as a television channel identified as "SHP" or "TV Shop."³ To order a product displayed on the user's screen, the user first depresses the select button to highlight the order icon. A personal identification order number window is displayed in which the user (using the numeric keypad on the remote control device) inputs a personal identification number (PIN). After entering the PIN, the ok or select button is depressed to order the product. Once the PIN is

³ Florin, 23: 19-23.

entered into the system, a signal is provided to the service provider and a confirmation of the order, along with a delivery time is displayed to the user.⁴

The Office Action asserts that "[t]he inputting of PIN causes automatically retrieving personal information previously stored the retrieved personal information pertaining to a user associated with the client system for making payments" and cites Florin at 12: 63 - 13: 6 and at 22: 32-41. The Office Action does not address the limitation as recited in claim 1, namely, *the personal information previously stored in the client system*, but instead disregards the requirement that the personal information is stored *in the client system* and sites Florin that clearly does not disclose storing personal information at the client system, and furthermore does not explicitly disclose automatically retrieving personal information.

Florin, as explained above, describes the use of the numeric pad of a remote control device, including permitting a user to enter the PIN or other information (e.g., telephone numbers) using the numeric pad. The passages in Florin relied upon by the Office Action to show this feature are reproduced below:

The fourth control button group is the numeric keypad panel 176, which permits the user to directly enter channel numbers to be viewed on the TV 58 by pressing a single, double or triple digit number, followed by the ok button 178 (FIG. 5a). For the remote control device 60 shown in FIG. 4b, the user would depress the select button 155 after entering values using the keypad 176. In addition, the numeric keypad 176 may be used by the user to enter a personal identification number ("PIN"), to be transmitted to the service provider 50 through the A/V connect module 66 for payment of pay-per-view movies, products and the like.⁵

Other functions may be realized with the present invention, including numeric data entry. As shown in FIGS. 41 and 49, by pressing one or more buttons on the numeric keypad 176 of the remote control device 60, a user can confirm a financial transaction by entering his or her personal identification number (PIN) in a confirmation display field 425. The numeric keypad 176 may also be used for dialing TV channel numbers, telephone numbers and other program source identifiers, as desired.⁶

⁴ Florin, 24: 39-55.

⁵ Florin, 12: 63 - 13: 6.

⁶ Florin, 25: 33-41.

While Florin permits manual input of a PIN or a telephone number, Florin does not discuss explicitly a capability of a system to automatically retrieve personal information pertaining to a user associated with the client system and provides no indication of where any such personal information would be kept. In contrast, claim 165 requires "automatically retrieving personal information ... previously stored ... in the client system."

The Office Action correctly observed that Florin fails to explicitly disclose that the retrieved personal information is previously stored in a permanent memory of the client system.

The Office Action cites Garneau even though Garneau also does not disclose that the retrieved *personal information is previously stored in a permanent memory of the client system*. The Abstract in Garneau relates to a method of distributing signals to valid subscribers.⁷ In Garneau, when a subscriber inputs a number corresponding to a particular program or code into a subscriber terminal, the terminal retrieves a logical or physical ID of the terminal. This ID, that may be stored in ROM, is used at the central station to determine whether the terminal is associated with a valid subscriber terminal number.⁸ Garneau does not explicitly disclose that the ID of the terminal is previously stored in a ROM of the client system. The Office Action thus effectively ignores the requirement that the personal information is previously stored in a permanent memory of *the client system*. Furthermore, a logical or physical ID of the terminal in Garneau is not personal information of a user, as it merely pertains to a piece of hardware. Garneau therefore fails to disclose or suggest "retrieving personal information previously stored ... in the client system" recited in claim 165.

Thus Florin fails to explicitly disclose retrieving personal information that was previously stored in a permanent memory; and is completely silent as to where any such personal information might be stored, and certainly does not disclose storage of such information on the client system. Garneau, on the other hand, fails to mention the retrieving of any personal information. Thus the combination of these references does not, and cannot, disclose or suggest the recited limitation of "automatically retrieving personal information ... previously stored ... in

⁷ Garneau, Abstract.

⁸ Garneau, 2: 15-47.

the client system," as recited in claim 165. Thus, because Florin fails to disclose or suggest the features of claim 165, claim 165 and its dependent claims are patentable and should be allowed. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claim 218 recites a processing unit to "automatically retrieve personal information previously stored in a permanent memory in the client system." Thus, the combination of the applied prior art references is deficient for the same reasons as discussed above, and claim 218 and its dependent claims are patentable for at least the reasons articulated with respect to claim 165. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claim 252 recites a processing unit to "automatically retrieving personal information previously stored in a permanent memory in the client system." Thus, claim 252 and its dependent claims are patentable for at least the reasons articulated with respect to claim 165. Applicants respectfully request reconsideration and withdrawal of the rejection.

Filing Date: July 10, 2001

Title: APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM,
AND METHOD AND SYSTEM TO ORDER AN ITEM USING A DISTRIBUTED COMPUTING SYSTEM

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 12, 2009.

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